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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,803	04/24/2001	Michael J. Jones	10006859-1	6813

7590 04/18/2006

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EXAMINER

HUNTSINGER, PETER K

ART UNIT PAPER NUMBER

2625

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/841,803

Applicant(s)

JONES, MICHAEL J.

Examiner

Peter K. Huntsinger

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-21,23-31 and 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-21,23-31 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/3/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 2/6/06 have been fully considered but they are not persuasive.

The applicant argues on pages 2 and 3 of the response in essence that:

Neither Nozaki nor Antognini teach the claimed relationships implemented on a medium in the claimed matter.

- a. The examiner respectfully disagrees. Nozaki et al. disclose an image processor that inputs and corrects at least one user specified image into a processed image digital file (exposure control unit 110, col. 7-8, lines 50-58, 1-19); an encoder that converts a user specified digital file into a pattern (code data generating unit 120, col. 8, lines 20-39); and a printing device (printer 30, col. 6-7, lines 45-58, 1-6) coupled to said image processor and coupled to said encoder to print said user specified image from said processed image digital file on a first side of the hardcopy medium and print said pattern as a plurality of machine readable marks on a second side of the hardcopy medium (col. 3, lines 33-36). Nozaki et al. do not disclose expressly converting the image into a pattern and printing the pattern. Antognini et al. disclose converting a digital image into a pattern and printing the pattern (col. 9, lines 29-36). Nozaki et al. and Antognini et al. are combinable because they are from the same field of encoding digital information into a computer readable pattern. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to convert a

digital image into a pattern instead of a link to the image. The motivation for doing so would have been to allow the computer to read the pattern without already having the stored image.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim includes encoding said at least one image file and a user selected digital file, and then printing said encoded file. It is indefinite as to which encoded file is being printed.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 4-8, 10-15, 18-21, and 23-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nozaki et al. EP 0928986, and further in view of Antognini et al. Patent 6,176,427.

Referring to claim 1, Nozaki et al. disclose an apparatus that prints user specified material on a hardcopy medium having at least two sides (photo processing apparatus 1, col. 6, lines 42-46), comprising: an image processor that inputs and corrects at least one user specified image into a processed image digital file (exposure control unit 110, col. 7-8, lines 50-58, 1-19); an encoder that converts a user specified digital file into a pattern (code data generating unit 120, col. 8, lines 20-39); and a printing device (printer 30, col. 6-7, lines 45-58, 1-6) coupled to said image processor and coupled to said encoder to print said user specified image from said processed image digital file on a first side of the hardcopy medium and print said pattern as a plurality of machine readable marks on a second side of the hardcopy medium (col. 3, lines 33-36). Nozaki et al. do not disclose expressly converting the image into a pattern and printing the pattern. Antognini et al. disclose converting a digital image into a pattern and printing the pattern (col. 9, lines 29-36). Nozaki et al. and Antognini et al. are combinable because they are from the same field of encoding digital information into a computer readable pattern. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to convert a digital image into a pattern instead of a link to the image. The motivation for doing so would have been to allow the computer to read the pattern without already having the stored image. Therefore, it would have been obvious to combine Antognini et al. with Nozaki et al. to obtain the invention as specified in claim 1.

Referring to claim 2, Nozaki et al. disclose an apparatus in accordance with claim 1 wherein said apparatus further comprises a kiosk (col. 13, lines 9-29) (col. 17, lines

36-44). The computer can be considered a kiosk because it is an electronic device that provides information (via a display), is interactive in nature (a multimedia combination), and allows for input (via an input device such as a touch screen or a keyboard). The kiosk is unique from a standard pc as it is created for a specific user and specific purpose and is owned, controlled, and operated by a business.

Referring to claim 4, Nozaki et al. disclose an apparatus in accordance with claim 1 further comprising a sound processor coupled to said encoder to create an audio digital file for specification as said user specified digital file (col. 8, lines 20-39).

Referring to claim 5, Nozaki et al. disclose an apparatus in accordance with claim 1 further comprising a data processor coupled to said encoder to create a data digital file for specification as said user specified digital file (col. 8, lines 20-39).

Referring to claim 6, Nozaki et al. disclose an apparatus in accordance with claim 1 further comprising a document composer coupled to said image processor and said encoder to receive input for said first side and said second side, respectively, and coupled to said printing device to provide a duplexed output to said printing device (col. 3, lines 33-36).

Referring to claim 7, Nozaki et al. disclose an apparatus in accordance with claim 1 further comprising an interface device by which a user may enter formatting commands at least to said image processor (monitor 102, col. 8, lines 13-19).

Referring to claim 8, Nozaki et al. disclose a method of creating user specified material on a hardcopy medium having at least two sides, comprising the steps of: accepting at least one image file (#1 of Fig. 9, col. 12, lines 45-48); encoding a user

Art Unit: 2625

selected digital file (#8 of Fig. 9, col. 14, lines 9-13); printing an image from said accepted at least one image file on a first surface of the hardcopy medium (#10 of Fig. 9, col. 14, lines 47-51); and printing said encoded file as a plurality of machine readable marks on a second surface of the hardcopy medium (col. 3, lines 33-36). Nozaki et al. do not disclose expressly converting the image into a pattern and printing the pattern. Antognini et al. disclose converting a digital image into a pattern and printing the pattern (col. 9, lines 29-36). Nozaki et al. and Antognini et al. are combinable because they are from the same field of encoding digital information into a computer readable pattern. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to convert a digital image into a pattern instead of a link to the image. The motivation for doing so would have been to allow the computer to read the pattern without already having the stored image. Therefore, it would have been obvious to combine Antognini et al. with Nozaki et al. to obtain the invention as specified in claim 8.

Referring to claim 10, Nozaki et al. disclose a method in accordance with the method of claim 8 wherein said step of accepting said at least one user selected image file further comprises the step of selecting an input for said at least one image file (col. 12, lines 45-48).

Referring to claim 11, Nozaki et al. disclose a method in accordance with the method of claim 10 wherein said step of selecting an input further comprises the step of selecting an input of an external camera (col. 12, lines 45-48).

Referring to claim 12, Nozaki et al. disclose a method in accordance with the method of claim 10 wherein said step of selecting an input further comprises the step of selecting an input of a user stored scanned image (col. 12, lines 45-48).

Referring to claim 13, Nozaki et al. disclose a method in accordance with the method of claim 10 wherein said step of selecting an input further comprises the step of selecting an input of an image negative or positive for scanning to create an at least one user selected image file (col. 17, lines 36-44).

Referring to claim 14, Nozaki et al. disclose a method in accordance with the method of claim 10 wherein said step of selecting an input further comprises the step of selecting an input of a previously stored image file (col. 17, lines 36-44).

Referring to claim 15, Nozaki et al. disclose a method in accordance with the method of claim 14 wherein said step of selecting an input of a previously stored image file further comprises the step of providing a link to an accompanying audio file (col. 13, lines 20-25).

Referring to claim 18, Nozaki et al. disclose a method in accordance with the method of claim 8 wherein said step of encoding a user selected digital file further comprises the step of accepting a selection of a digital file (col. 13, lines 20-22).

Referring to claim 19, Nozaki et al. disclose a method in accordance with the method of claim 18 wherein said step of accepting a selection of a digital file further comprises the step of accepting a selection of a digital audio file (col. 13, lines 20-22).

Referring to claim 20, Nozaki et al. disclose a method in accordance with the method of claim 19 wherein said step of accepting a selection of a digital audio file

Art Unit: 2625

further comprises the step of selecting from a library of digital audio files (Fig. 10, col. 13, lines 20-29).

Referring to claim 21, Nozaki et al. disclose a method in accordance with the method of claim 19 wherein said step of accepting a selection of a digital audio file further comprises the step of activating a microphone (col. 12-13, lines 56-58, 1).

Referring to claim 22, Nozaki et al. disclose a method in accordance with the method of claim 18 wherein said step of accepting a selection of a digital file further comprises the step of accepting a selection of said at least one image file (col. 13, lines 13-20).

Referring to claim 23, Nozaki et al. disclose a method in accordance with the method of claim 18 wherein said step of accepting a selection of a digital file further comprises the step of accepting a selection of input data (col. 13, lines 20-22).

Referring to claim 24, Nozaki et al. disclose a method in accordance with the method of claim 8 wherein said step of accepting at least one image file further comprises the step of processing said accepted at least one user selected image file (col. 12, lines 48-53).

Referring to claim 25, Nozaki et al. disclose a method in accordance with the method of claim 8 wherein said step of encoding said user selected digital file further comprises the step of encoding said user selected digital file into a pattern (col. 14, lines 9-13).

Referring to claim 26, Nozaki et al. disclose a method in accordance with the method of claim 25 wherein said step of printing said encoded file further comprises the

step of depositing said pattern as said plurality of machine readable marks (col. 14, lines 9-13).

Referring to claim 27, Nozaki et al. disclose a method in accordance with the method of claim 8 further comprising the step of composing said accepted at least one user selected image file and said encoded user selected digital file for respectively printing on said first surface and said second surface of said hardcopy medium (col. 3, lines 33-36).

Referring to claim 28, Nozaki et al. disclose a hardcopy output produced in accordance with the method of claim 8 (col. 14, lines 47-51).

5. Claims 9, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nozaki et al. EP 0928986 and Antognini et al. Patent 6,176,427 as applied to claims 8 and 10 above, and further in view of Brennan Patent 5,587,740.

Referring to claim 9, Nozaki et al. disclose printing a user selected image but do not disclose expressly accepting payment for printing the image. Brennan discloses accepting payment for printing an image (col. 1, lines 53-55). Nozaki et al. and Brennan are combinable because they are from the same field of producing digital image prints. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to accept payment for printing digital images. The motivation for doing so would have been to provide a service to customers in exchange for a fee. Further, Nozaki et al. disclose a system utilized by a customer, which would suggest the owner of the system seeking compensation for providing services (col. 17, lines 36-44). Therefore, it

would have been obvious to combine Brennan with Nozaki et al. and Antognini to obtain the invention as specified in claim 9.

Referring to claim 16, Nozaki et al. disclose selecting an image input but do not disclose an internal camera input. Brennan discloses an internal camera image input (digital camera 26 of Fig. 3, col. 3, lines 36-42). Nozaki et al. and Brennan are combinable because they are from the same field of producing digital image prints. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to utilize an internal digital camera in the system of Nozaki et al. The motivation for doing so would have been to allow customers to produce a picture without the need for their own digital camera. Therefore, it would have been obvious to combine Brennan with Nozaki et al. and Antognini to obtain the invention as specified in claim 16.

Referring to claim 17, Nozaki et al. disclose a method in accordance with the method of claim 16 wherein said step of selecting an input further comprises the step of saving an image as said at least one image file (col. 7-8, lines 50-58, 1-5). Brennan discloses an internal camera image input (digital camera 26 of Fig. 3, col. 3, lines 36-42).

6. Claims 29, 30, 31, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nozaki et al. EP 0928986, and in further view of Braznell Patent 3,762,630 and Antognini et al. Patent 6,176,427.

Referring to claim 29, Nozaki et al. disclose a correspondence medium having at least two visible surfaces, comprising: a user-selected image disposed on a first visible

surface of the correspondence medium (col. 13, lines 13-20); and user-selected data, encoded in the form of machine-readable marks, disposed on said second visible surface of the correspondence medium and spaced apart from said postal frank. (col. 14, lines 7-13). Nozaki et al. do not disclose expressly a postal frank on a postcard. Braznell discloses a postal frank disposed on a second visible surface of the correspondence medium (Fig. 1 and 3). Nozaki et al. and Braznell are combinable because they are from the same field of printed material, specifically postcards. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include a postal frank on a postcard. The motivation for doing so would have been to allow an area for a postage stamp to be applied to the postcard for mailing. Nozaki et al. do not disclose expressly converting the image into a pattern and printing the pattern. Antognini et al. disclose converting a digital image into a pattern and printing the pattern (col. 9, lines 29-36). Nozaki et al. in view of Braznell and Antognini et al. are combinable because they are from the same field of encoding digital information into a computer readable pattern. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to convert a digital image into a pattern instead of a link to the image. The motivation for doing so would have been to allow the computer to read the pattern without already having the stored image. Therefore, it would have been obvious to combine Antognini et al. with Nozaki et al. to obtain the invention as specified in claim 29.

Referring to claim 30, Nozaki et al. disclose a correspondence medium in accordance with claim 29 wherein said first user-selected data further comprises a digital audio file (col. 14, lines 7-13).

Referring to claim 31, Nozaki et al. disclose a user-selected image. Antognini et al. disclose converting a digital image into a pattern and printing the pattern (col. 9, lines 29-36).

Referring to claim 33, Nozaki et al. disclose a correspondence medium in accordance with claim 29 wherein said first user-selected data further comprises a digital file of input data (col. 12-13, lines 56-58, 1).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2625

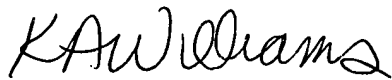
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571)272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PKH



KIMBERLY WILLIAMS
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